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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,218	10/03/2005	Xavier Blin	05725.1417-00000	2030
22852	7590	02/12/2010		
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EXAMINER				
ORWIG, KEVIN S				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
02/12/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/529,218

Applicant(s)

BLIN ET AL.

Examiner

Kevin S. Orwig

Art Unit

1611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 80-83, 86, 87, 90-140 and 142-165.
Claim(s) withdrawn from consideration: 166-176.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Kevin S. Orwig/
Examiner, Art Unit 1611

/David J Blanchard/
Primary Examiner, Art Unit 1643

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claim 159 under 35 U.S.C. 112, second paragraph, is withdrawn in light of the claim amendments. The 112 1st paragraph rejections of claims 80-83, 86, 87, 90-140, 142-157, and 160-165 for NEW MATTER are withdrawn in light of applicants' arguments. Applicants are reminded of their responsibility to point out support for future claim amendments.

Continuation of 11. does NOT place the application in condition for allowance because:
The arguments presented by applicants are unpersuasive for at least the following reasons.

In the amended claims, applicants have done nothing more than rearrange previously presented limitations, which were properly rejected previously. Thus, the new arrangement of previously applied references discussed below still properly rejects the instant claims.

REJECTIONS WITHDRAWN:

The rejection of claim 159 under 35 U.S.C. 112, second paragraph, is withdrawn in light of the claim amendments.

The 112 1st paragraph rejections of claims 80-83, 86, 87, 90-140, 142-157, and 160-165 for NEW MATTER are withdrawn in light of applicants' arguments. Applicants are reminded of their responsibility to point out support for future claim amendments.

REJECTIONS MAINTAINED:

The double patenting rejections of record are maintained at the present time (see note below).

Claims 158 and 159 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

RESPONSE TO ARGUMENTS:

As discussed in the prior Office Action, written description support is lacking for the polymer in the claimed weight percentages. Contrary to applicants' arguments, there is no nexus in the instant application between the identity of the "active material" and the polymer. Applicants point to lines 20-24 at p. 48. However, this portion of the specification refers to active material (or solids) separately from block polymer. Thus, the ordinary artisan would reasonably have interpreted these to mean different components. The fact that the percentages discussed are "cascading" provides no clear proof of the alleged interchangeability of these terms since distinct components are often referred to in lists and often have "cascading" percentage ranges. Moreover, even if applicant could properly establish the interchangeability of these terms, the cited portion lacks support for the range 10-40% as recited in claim 159. Example 1, also referred to by applicants is of no more help since the phrase "polymer active material" (which was previously rejected as indefinite) begs the question(s): Is the active material a part of the polymer? If so, what part?

The rejection of claims 80-82, 86, 87, 90, 93, 103, 104, 144, 145, and 160-165 under 35 U.S.C. 103(a) over MOUGIN (U.S. 2002/0115780) in view of FRECHET (U.S. 6,663,855) and MELCHORS (U.S. 6,531,535).

RESPONSE TO ARGUMENTS:

Applicants argue that Mougin does not teach the instantly claimed polymer structure. Applicants' arguments are defective for at least several reasons. First, applicants are improperly narrowly interpreting the breadth of their claims, which are not limited to any particular structure of a block, the term "block" not even being defined in the instant application. Second, applicants are arguing against the references individually, when the rejection is over a combination of references. Third, the preferred embodiments of Mougin's invention do not teach away from or negate the full scope of Mougin's disclosure, which is not limited to preferred embodiments or examples. The alleged deficiencies of Mougin are made up for by Frechet and Melchors. Frechet clearly teaches the instant structure of the intermediate block (this is admitted by applicants at p. 28 of the present response) along with the claimed Tg values (see paragraph 2 of the prior Office Action). Applicants are reminded that a reference is good for all it teaches and is not limited to preferred embodiments or examples. The totality of Frechet's teachings clearly encompass the instantly claimed Tg values. Applicants argue that Frechet does not describe how to make the polymers it teaches and broadly assert that because Frechet is allegedly silent as to the Tg of R, the intermediate block does not have a Tg as instantly claimed. While this argument ignores the totality of Frechet's teachings and the reasoning presented in the prior Office Action, applicants have provided absolutely no evidence to support their assertion that the Tg of the intermediate segments taught by Frechet or Mougin could not have a Tg as instantly claimed nor has any evidence been provided to support the implication that an artisan would not know how to make the polymers taught by Frechet.

Applicants argue that Melchors does not teach a block copolymer, however, it is not necessary for Melchors to provide this teaching as it is present in both Mougin and Frechet. As discussed in the Office Action, the skilled artisan would have had the ability and motivation to modify the polydispersity of the composition based on the knowledge in the art without looking to Melchors, but Melchors is added to show the state of the art, particularly for polymer compositions having properties disclosed as useful by both Mougin and Frechet. Applicants state that the various examples of Melchors have different properties based on monomers and production processes. Applicants have not established that these differences are due to the polydispersity of the resultant polymers, and Melchors does not teach this. MPEP 2144.08 states "However, obviousness does not require absolute predictability, only a reasonable expectation of success, i.e., a reasonable expectation of obtaining similar properties." Applicants attention is drawn to examples 1-4 of Table 1, all of which have polydispersities of greater than 2.5, and all of which have excellent solvent resistance, hardness, and gloss. Melchors clearly establishes a reasonable expectation of success even if, in arguendo, some unpredictability is apparent. Again, no actual evidence has been presented to establish that any of the monomers of Anton or Frechet would be unpredictable. A prima facie case of obviousness has been established.

Claims 80-83, 86, 87, 90-140, and 142-165 are rejected under 35 U.S.C. 103(a) as being unpatentable over ANTON (U.S. Patent No.

6,153,206) in view of KANTNER (U.S. 2002/0076390), FRECHET, and MELCHIORES.

RESPONSE TO ARGUMENTS:

Applicants argue that the intermediate segment of the claimed block polymers is a random copolymer and allege that Anton and Frechet do not teach such a structure. Applicants argue that the preferred polymers of Frechet do not cure the alleged deficiencies of Anton.

Applicants argue that Frechet does not describe how to make the polymers it teaches and broadly assert that because Frechet is allegedly silent as to the Tg of R, the intermediate block does not have a Tg as instantly claimed.

Again, applicants are arguing against the references individually. As admitted by applicants, Anton teaches block polymers of varying architectures. It is noted that the central segment of a block copolymer such as that taught by Anton (IIIIIIIBBBBBBB) can be construed as a random block. For example, the segment IIBB that connects the IIIII and BBBBB blocks is a random copolymer. Because a random copolymer does not exclude this structure, Anton itself reads on the claim. A random copolymer is, by definition, random. Therefore, by random chance, the -IIBB- and -BBMM- could result. These intermediate segments meet the instant claim language, which is extremely broad and places virtually no structural limitations on the intermediate segment. If applicants intend a different structure, the scope of the claim should be amended to reflect this. Moreover, Frechet clearly teaches the instant structure of the intermediate block along with the claimed Tg values (see paragraph 9 of the prior Office Action). Applicants are reminded that a reference is good for all it teaches and is not limited to preferred embodiments or examples. The totality of Frechet's teachings clearly encompass the instantly claimed Tg values.

Applicants argument regarding Frechet's alleged silence on the Tg values of the segments ignores the totality of Frechet's teachings and the reasoning presented in the prior Office Action. Further, applicants have provided absolutely no evidence to support their assertion that the Tg of the intermediate segments taught by Frechet (or Anton) could not have a Tg as instantly claimed nor has any evidence been provided to support the implication that an artisan would not know how to make the polymers taught by Frechet.

Applicants argue that Kanter teaches the elected species as monomers for forming copolymers, but not blocks thereof. Any skilled artisan reading Kanter would immediately envisage the use of the monomers taught in blocks. Block copolymers fall within the category of copolymers taught by Kanter, and Frechet teaches the instantly claimed structure, as discussed above. Kanter establishes the utility of the instantly claimed monomers in related cosmetic polymer formulations.

Applicants argue that some monomers taught by Mougins and Frechet would yield unpredictable results in terms of polydispersity.

Applicants are reminded that all that is required to meet the claim language is a recognition in the art that polydispersity values greater than 2.5 have been useful in similar applications, which teaching is taught by Melchior. Applicants state that the various examples of Melchior have different properties based on monomers and production processes. Applicants have not established that these differences are due to the polydispersity of the resultant polymers, and Melchior does not teach this. MPEP 2144.08 states "However, obviousness does not require absolute predictability, only a reasonable expectation of success, i.e., a reasonable expectation of obtaining similar properties." Applicants attention is drawn to examples 1-4 of Table 1, all of which have polydispersities of greater than 2.5, and all of which have excellent solvent resistance, hardness, and gloss. Melchior clearly establishes a reasonable expectation of success even if, in arguendo, some unpredictability is apparent. Again, no actual evidence has been presented to establish that any of the monomers of Anton or Frechet would be unpredictable.

TERMINAL DISCLAIMERS

The four terminal disclaimers submitted by applicants are acknowledged. At this time, the terminal disclaimers are awaiting review by the USPTO legal staff and have not yet been approved. Thus, the double patenting rejections are maintained until such approval is given.